IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

APPELLANTS:	Boehler et al.	GROUP ART UNIT: 2173
SERIAL NO.:	10/038,167	EXAMINER: Dennis G. Bonshock
FILED:	October 23, 2001	CONFIRMATION NO.: 7809
TITLE:	"DIAGNOSTIC DEVICE WITH MOUSE-CONTROLLED SWITCHING AMONG DISPLAY CONTROL FUNCTIONS"	

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
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S I R:

Under the provisions of 37 C.F.R. §41.41, Appellants herewith submit their Reply Brief, in response to the Examiner's Answer dated February 23, 2006.

At page 2 of the Examiner's Answer, the Examiner stated that Appellants' statement, in Appellants' Main Brief on Appeal, of the grounds of rejection to be reviewed on appeal is correct. That statement of the grounds for review on appeal, however, was taken from the final rejection, and in the Appeal Brief Appellants noted discrepancies between the grounds for rejection stated in the final rejection, and the substantiation of those rejections in the Final Rejection. In particular, Appellants noted that it seemed contradictory to leave the Fenster et al. reference out of the rejections of claims 5, 6, 7 and 8, because all of those claims depend from independent claim 1, and it was necessary (according to the Examiner) to rely on the Fenster et al. reference as a basis for rejecting claim 1.

Despite the aforementioned agreement with Appellants' statements of the grounds of rejection to be reviewed on appeal, the Examiner agreed (at page 22 of

the Examiner's Answer) that the previous Examiner had made a typographical error in omitting the Fenster et al. reference from the statement of the rejection of the aforementioned dependent claims. The current Examiner has included the Fenster et al. reference in the current Examiner's own statement of those rejections in the Examiner's Answer. Therefore, it seems that the current Examiner should not have stated that Appellants statement of the grounds to be reviewed on appeal is correct.

If any further clarification is needed, Appellants agree that the Fenster et al. reference should be included as one of the references forming the basis of the rejection of each of claims 5, 6, 7 and 8, and Appellants provided arguments in Appellants' Main Brief on Appeal based on that assumption. Appellants were constrained to state the grounds for review on appeal in the form as presented in the final rejection, but acknowledge that the statements of the rejections in the Examiner's Answer are, in fact, correct.

In response to the Examiner's specific disagreements, beginning at page 15, with the arguments in support of patentability presented by the Appellants in their Main Brief, Appellants respond as follows.

The Examiner has acknowledged that the Saito et al. reference does not disclose the limitation of claim 1 of the image system selecting a control function, from among a plurality of different control functions respectively uniquely associated with different predetermined movement directions of the mouse, by detecting movement of the mouse in one of those predetermined directions and then selecting the control function that is uniquely associated with that direction, in order to alter the display of the image at the display unit.

The Examiner relied on the Fenster et al. reference as providing such a teaching. Even with the general rule for claim interpretation cited by the Examiner, requiring an Examiner to give claim language its broadest reasonable interpretation, Appellants submit that the Fenster et al. reference teaches, and necessarily uses, one and only one control function. Appellants acknowledged in their Main Brief that when this single control function is applied to continuously changing inputs (i.e., continuously changing mouse-movement), this results in the appearance of the display changing. This is not, however, because a different control function is being applied, but is a result of the same control function being applied to differing inputs, which thus necessarily produces a different output, which in turn causes a change in the appearance of the display.

Appellants also acknowledged the example relied upon by the Examiner, wherein the display is caused to rotate around respectively different axes dependent on the direction that the mouse cursor is being dragged on the screen. Figures 7A and 7B of the Fenster et al. reference make explicitly clear that this change in the display appearance nevertheless is a result of one and only one control function being employed. This is the control function in step 334, which is "calculate movement and track movement with cursor on screen." If there were more than one control function involved in the Fenster et al. reference, there would have to be multiple ways of reaching step 334, in order to designate which control function among (alleged) multiple control functions in step 334 is to be selected or activated, or there would have to be multiple sub-steps in, or proceeding from, step 334 respectively directed to such (alleged) different control functions. Since nothing of the sort is shown in Figures 7A and 7B of the Fenster et al. reference (there is only

one way to get to step 334, and there is only one function that is performed in step 334), this makes it clear that the Fenster et al. reference does not allow or contemplate different control functions dependent on different directions of mouse movement, as set forth in claim 1.

As also discussed in Appellants' Main Appeal Brief, the Fenster et al. reference does allow selection of different control functions, but this proceeds in parallel with, and completely independently of, anything that takes place in step 334. In step 336 in Figure 7A, it is first detected whether the cursor is in the main display window, and if the outcome of this inquiry is "no", the flowchart proceeds to step 338, to determine whether the cursor is over an option icon. If the outcome of step 338 is "yes", then the option icon routine is invoked. It is abundantly clear that the invoking of the option icon routine in step 338 is completely independent of the calculation that takes place in step 334.

Appellants cannot stress strongly enough the importance of not confusing a changing appearance on a display screen that results from the same control function being continuously applied to a varying input (that may include a continuous varying movement), with the claimed subject matter of changing the appearance on the display screen by applying a *different* control function dependent on the detected movement direction.

Claim 3 of the claims on appeal provides different examples of the type of different control functions that can be selected dependent on the detected movement. As can be seen, each of these different types of control functions effects a completely different and unrelated type of calculation, and results in a radically different appearance on the display screen. This is in contrast to the Fenster et al.

reference, wherein the different directions of movement result in the image on the display screen being rotated in different directions and/or around different axes, but these different appearances are basically the same calculation made with different inputs, which is why they can both be performed in the aforementioned step 334. By contrast, the examples in dependent claim 3 result from completely different types of calculations, which is why they are differently selected dependent on the different detected movement directions, and are respectively unique for the different movement directions.

Appellants therefore believe that the rejection of claims 1-9 should be reversed.

An oral hearing pursuant to 37 C.F.R.§ 41.47 has been requested by means of a separately-filed Request.

Submitted by,

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I hereby certify that an original and two copies of this correspondence are being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 20, 2006.

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